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In re Application of  
Kazuhiro FUJII : DECISION ON PETITION  
Application No. 10/826,272 : UNDER 37 CFR §1.181  
Filed: June 15, 2001 :  
For: ELECTRICAL BICYCLE SHIFT :  
CONTROL DEVICE :  
:

This is a decision on applicant's petition under 37 CFR 1.181 filed January 15, 2008 to request the withdrawal of the objection to the amendment filed on August 2, 2007 for allegedly introducing new matter in the disclosure, as set forth in the November 15, 2007 final Office action.

The petition is **GRANTED**.

A review of the record reflects that on August 2, 2007, applicant filed an amendment in response to a non-final Office action dated April 18, 2007.

In the August 2, 2007 amendment, applicant amended the drawings, the specification and claims 1, 2, 6, 11, 12, 14, 15, 17-19, 22, 26 and 28. More specifically, the applicant amended the drawings and specification to illustrate a plane P and provide reference numerals for split S for features set forth in amended claim 22, and to provide proper antecedent basis for the new claim language added in amended claim 22.

On November 15, 2007, the examiner issued a final Office action in response to the August 2, 2007 amendment. In this final Office action, the examiner indicated that the applicants' August 2, 2007 amendment introduced new matter into the disclosure (drawings and specification), since the plane P was not disclosed in the application as originally filed, and since the concept that plane P being perpendicular to the operating axis X and passing through the center axis C of the transverse portion T of the handlebar 14 as shown in the amended figure 7, was not conveyed in the disclosure as originally filed.

Applicant asserts that plane P, which is perpendicular to the rotation axis X and passes through the center axis C to figure 7, does not constitute an introduction of new matter since such a plane was inherently present in original figure 7, but was merely not yet explicitly identified. The applicant argues that a plane that is perpendicular to the rotation axis X and passes through the center axis C is inherently present in original figure 7, and thus, is merely being clearly, explicitly identified as plane "P" by the August 2, 2007 amendment, and that the changes to figure 7 and the specification were made in view of the changes to claim 22 and in view of an objection in the April 18, 2007 Office action that "a mating mounting structure" set forth in the claims was not identified with a reference numeral.

MPEP 608.04(a) sets forth that matter not in the original specification, claims, or drawings is usually new matter. In the instant application, amending figure 7 and the specification to show a plane P perpendicular to the operating axis X and passing through the center axis C, in relation to structure that was originally filed, do not constitute new matter since plane P inherently existed prior to amending the drawings, and was therefore disclosed at the time of filing. Therefore, the holding of new matter made in the November 15, 2007 final Office action is hereby withdrawn.

Summary: The petition is **GRANTED**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Richard Ridley at 571-272-6917.



Frederick Schmidt, Director  
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